

ESTTA Tracking number: **ESTTA591873**

Filing date: **03/11/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	E. & J. Gallo Winery
Granted to Date of previous extension	03/12/2014
Address	600 Yosemite Blvd. Modesto, CA 95354 UNITED STATES
Correspondence information	Steven M. Weinberg Attorney of Record HOLMES WEINBERG, PC 30765 Pacific Coast Hwy. Suite 411 Malibu, CA 90265 UNITED STATES hwtrademarks@gmail.com, msalvatore@holmesweinberg.com Phone:310 457 6100

Applicant Information

Application No	85962393	Publication date	11/12/2013
Opposition Filing Date	03/11/2014	Opposition Period Ends	03/12/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	GC. DESIGN S.R.L. Via dell'Artigianato 37 (FIRENZE), ITX ITX		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Clothing, namely, T-shirts; shirts; pants; trousers; suits; sweaters; jumpers; cardigans; jackets and vests; coats; overcoats; raincoats; scarves; ties, neckties; belts; footwear; headwear

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1904572	Application Date	06/09/1994
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Registration Date	07/11/1995	Foreign Priority Date	NONE
Word Mark	CARLO ROSSI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1962/00/00 First Use In Commerce: 1962/00/00 wines		

Attachments	2014.03.11_Notice of Opposition re GIAN CARLO ROSSI.pdf(22524 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nelda Piper/
Name	Nelda Piper
Date	03/11/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Serial No. 85/962,393

E. & J. Gallo Winery,

Opposer,

v.

GC Design S.R.L.,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

TO: ASSISTANT COMMISSIONER FOR TRADEMARKS
BOX TTAB –FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Opposer E. & J. Gallo Winery (“Gallo”), a corporation organized and existing under the laws of the State of California, believes that it would be damaged by registration of the above-referenced mark, and hereby opposes the same. As grounds for this Opposition, Gallo respectfully alleges as follows:

1. Opposer Gallo is a corporation organized and existing under the laws of the State of California, having a place of business at 600 Yosemite Blvd., Modesto, California 95354.
2. Gallo is the exclusive owner in the United States of the federally registered trademark CARLO ROSSI for “wines” (Reg. No. 1904572), as registered on the Principal Register on July 11, 1995 (the “CARLO ROSSI® Mark”).
3. This registration is valid and enforceable, and Gallo’s exclusive rights in the CARLO ROSSI® Mark are incontestable.

4. Gallo has used the CARLO ROSSI trademark in the United States since at least as early as 1962. For more than fifty years, Gallo has produced, advertised, promoted, distributed and sold wines in interstate commerce under its CARLO ROSSI® Mark.

5. Throughout the past fifty years, the CARLO ROSSI® Mark has become very well known to consumers of wines and related products, including clothing.

6. Many wine brands, including several wine brands owned by Gallo, use wine marks on clothing items.

7. The mark subject to this Opposition is GIAN CARLO ROSSI, Serial No. 85/962,393 (the “Opposed Mark”) for “Clothing, namely, T-shirts; shirts; pants; trousers; suits; sweaters; jumpers; cardigans; jackets and vests; coats; overcoats; raincoats; scarves; ties, neckties; belts; footwear; headwear,” in International Class 025.

8. Applicant filed United States Application Serial No. 85/962,393 with the U.S. Patent and Trademark Office on or about June 18, 2013. The Application for the Opposed Mark is based on a European Community trademark registration.

9. Because Gallo first used the CARLO ROSSI® Mark on wines several decades before Applicant filed its application for the Opposed Mark or used the Opposed Mark in United States commerce, and Gallo’s use has been continuous, Gallo has priority of use.

10. By virtue of Gallo’s long, continuous, extensive and exclusive use and marketing, promotion and sale of wines under the CARLO ROSSI® Mark, the CARLO ROSSI® Mark has come to be recognized by the public as identifying wines and related products having their origin or otherwise associated exclusively with Gallo.

11. The Opposed Mark for the International Class 025 goods is confusingly similar, *inter alia*, in appearance and overall commercial impression to the CARLO ROSSI® Mark. For

example, both the CARLO ROSSI® Mark and the Opposed Mark are comprised of the words CARLO ROSSI. Thus, the Opposed Mark evokes the same or a highly similar connotation as the CARLO ROSSI® Mark. Applicant's stated goods for the Opposed Mark are related to the goods for which Gallo uses the CARLO ROSSI® Mark. Specifically, many wine brands use their marks on clothing items, including several Gallo wine brands. Accordingly, consumers have become accustomed to seeing wine marks in use on clothing products. Thus, it is likely that consumers will mistakenly believe that the Opposed Mark for the International Class 025 goods is connected to or associated with Gallo or its CARLO ROSSI® wines.

12. The registration of the Opposed Mark would be inconsistent with Gallo's rights in its CARLO ROSSI® Mark and will cause damage to Gallo.

WHEREFORE, Gallo respectfully prays that registration of the Opposed Mark not be permitted.

DATED this 11th day of March, 2014.

Respectfully submitted,

By: /s/ Steven M. Weinberg
Steven M. Weinberg
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Malibu, CA 90265
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Attorneys for Opposer E. & J. Gallo Winery

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing NOTICE OF OPPOSITION was served by U.S. Priority Mail and email to Applicant's counsel at the following address:

Mark Lebow
Ladas & Parry LLP
1727 King Street, Suite 105
Alexandria, VA 22314
mlebow@ladas.com

DATED: March 11, 2014

By: /s/ Nelda Piper
Nelda Piper
Paralegal